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IN THE

Supreme Court of the United States

OCTOBER TERM, 1943.

No. 262

THE GOODYEAR TIRE & RUBBER COMPANY, INC., AND GENERAL DRY BATTERIES, INC.,
Petitioners,

vs.

RAY-O-VAC COMPANY,
Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

SUPPLEMENTAL STATEMENT OF THE MATTER INVOLVED.

There is no conflict of decisions in different Circuits, and Petitioners are believed to be the only infringers of the patent in suit. The patent was held valid and infringed by Judge Lindley, the senior district judge of the Seventh Circuit, and the decision and findings were affirmed by the unanimous decision of the Court of Appeals for the Seventh Circuit. There was no petition for rehearing.

The dry battery industry is not concentrated in the Seventh Circuit and there should be ample opportunity to test the patent in other Circuits because there are other

large competitors located in the Second, Third, Sixth, Seventh and Eighth Circuits.

Petitioner, General Dry Batteries, Inc., admittedly had full knowledge of the patent in suit, issued April 23, 1940, at the time it commenced the manufacture and sale of the infringing cells (Rec. 48, paragraph 5 of the stipulation). By that time respondent's patented cell had already achieved considerable commercial success and millions of the patented cells had been sold to the public (Plaintiff's Exhibit 24, Rec. 121).

Respondent's, Ray-O-Vac, leak-proof cell is recognized by the United States Army Signal Corps as being without a peer. Since the trial of the case, manufacture of this cell for civilian use has been discontinued because of the steel shortage and the cell is now made exclusively for the armed forces. Respondent has supplied promptly all the leak-proof cells ordered by the armed forces without using its full capacity to make the cells.

The government may use any invention without license from the owner and can order the patented cells from Petitioners without danger of any injunction or contempt proceedings against Petitioners (35 U. S. C. A., Sec. 68). When Petitioner, General Dry Batteries, Inc., advised Respondent that it wished to manufacture an infringing dry-cell known as BA-37, Respondent immediately gave it a royalty-free license to furnish the desired cells for the government.

The dry-cell art is quite old, and the dry-cell industry is quite large and highly competitive (Rec. 51). Leakage of corrosive electrolyte from exhausted cells, and damage to flashlight casings from such leakage and swelling of old cells have plagued the industry from the beginning. Petitioners conceded "that leakage has been a problem for a long time", and in response to the Court's question also conceded that the problem was "generally recognized" (Rec. 63).

The inventor of the patent in suit, discovered that he could prevent leakage in the cell as used commercially, and could completely overcome the even more serious problem of swelling dry-cells. He accomplished this by providing a steel jacket, insulated from both electrodes, for the side walls of the zinc cup, which grips the end closures with sufficient mechanical strength to withstand not only the gas pressure developed but also the mechanical pressure of expanding solids which form in the cell as the zinc is eaten away. This pressure may be as high as 100 pounds per square inch (Rec. 112), and the inventor was the first to confine it in a dry-cell.

In addition to conserving and protecting valuable equipment from losses through leakage and swelling, the invention provides a cell which has a markedly improved "shelf life" and performance. This was proven by reliable tests conducted by the Bureau of Standards and others (Rec. 59-61).

Claim 1 of the patent application was narrowed slightly by amendment and became claim 1 of the patent in suit. It was uniformly treated by the Patent Office and applicant as generic to the various forms, and of the scope later given by the courts below (Rec. 138, Finding 16). Respondent's brief and appendix thereto ignores the limitation in the claims in suit that the sheet metal sheath must also be insulated from both electrodes. Cancellation "without prejudice" of a claim and putting it into a copending continuation-in-part patent application in no way reduces the scope of a broader already allowed claim.

The patent in suit was the first to teach the sealing up and confining of the pressure in a cell. In spite of Petitioner's contentions to the contrary, the courts all agreed that not one of the prior art references shows a steel jacket for a dry-cell intended or adapted to perform the functions of the novel jacket of the patent in suit.

ARGUMENT.

Petitioners comment in their brief that the opinion of the District Court, including the findings and conclusions, takes thirteen pages of the record while the opinion of the Circuit Court of Appeals takes but four pages. If the petitioners felt that the Court of Appeals overlooked any defense, which we deny, they should not have failed to apply for a rehearing.

There is no concentration of the dry battery industry in any particular circuit. Petitioner, General Dry Batteries, Inc., has a plant in Cleveland, Ohio and in Dubuque, Iowa. Respondent, Ray-O-Vac Company, makes the patented cells in Madison, Wisconsin and in Lancaster, Ohio. Some of the large competitors in this field are located as follows:

Bond Electric Corporation, at New Haven, Connecticut.

Bright Star Battery Co., at Clifton, New Jersey.

U. S. Electric & Mfg. Co., at New York City, N. Y.

National Carbon Co. (Every Ready Batteries), at Cleveland, Ohio.

Burgess Battery Co., at Freeport, Illinois.

Marathon Battery Co., at Wausau, Wisconsin.

There should be ample opportunity to test the patent in other circuits and another infringer might bring a suit for a Declaratory Judgment in any one of several circuits where respondent operates.

Petitioners' main argument for the grant of the writ appears to be based on the fact that the patented cell of respondent is used in large quantities by the armed forces. So far as we know no other leak-proof construction has been approved (Rec. 77), and there is nothing in the rec-

ord to show that General Dry Batteries, Inc. has even offered its infringing cell to the armed forces.

Respondent, Ray-O-Vac, is proud to have supplied promptly all the leak-proof cells requested by the armed forces, but the government may have the identical cells manufactured by Petitioners or anyone it desires (35 U. S. C. A., Sec. 68). This month, August, 1943, only two million of these cells were ordered for the armed forces, and Respondent has manufactured as many as twelve million in one month without utilizing its full capacity of about fifteen million per month. Respondent was awarded and has the Army and Navy "E" pennant. Respondent's willingness to grant licenses has already been demonstrated by giving Petitioner, General Dry Batteries, Inc., a license to make an infringing cell known as BA-37 for the government. The license was given immediately when requested and no royalty was charged.

Petitioners refer to Colonel Clark's letter (Rec. 73) in a way that might indicate the Army needed more of the patented cells than it was getting. The purpose of the letter, as it shows on its face, was to tell the War Production Board that cell sizes must not be standardized to the extent of eliminating the important leak-proof cell. At the same time Colonel Clark gave Respondents a box of cells (See photographs Rec. 117-120) to show why the leak-proof cell was needed and conserved valuable equipment at the battle front.

Petitioners did not seriously dispute that invention was present in the patent suit. In their brief before the Court of Appeals they said: "We are not seeking to have the three claims in suit declared invalid." At the trial respondents conceded that leakage has been a problem for a long time and generally recognized. This Court has always held that where a device fills a long felt want and meets with a remarkable and immediate commercial suc-

cess, invention is to be inferred rather than mechanical skill. For example, in *Paramount P. Corp.* v. *American Tri-Ergon Corp.*, 294 U. S. 464, 474, 79 L. Ed. 997, 1003, this Court recently said:

> "Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want. See *Webster Loom Co.* v. *Higgins*, 105 U. S. 580, 591, 26 L. Ed. 1177, 1181; *Krementz* v. *S. Cottle Co.*, 148 U. S. 556, 560, 37 L. Ed. 558, 559; 13 S. Ct. 719; *Hobbs* v. *Beach*, 180 U. S. 383, 392, 45 L. Ed. 586, 592, 21 S. Ct. 409; *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403, 429, 430, 46 L. Ed. 968, 983, 22 S. Ct. 698; *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 381, 53 L. Ed. 1034, 1040, 29 S. Ct. 652."

The questions of infringement and file wrapper estoppel were fully briefed and argued in the Courts below and all of the four judges reached the conclusion that the accused cells infringed and that clearly there was no file wrapper estoppel. The matter is fully covered by the opinion and findings of the District Court (Rec. 126-139) which were affirmed by the Court of Appeals (Rec. 247-250). A lengthy study of the exhibits and record is necessary to review those questions.

CONCLUSION.

There being no conflict between any of the decisions on the patent in suit and there being no new question of law or public interest involved, the Petition for a Writ of Certiorari in this case should be denied.

Respectfully submitted,

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Chicago, Illinois,
September 3, 1943.

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